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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,566	02/03/2005	Kazuhiro Yagishita	CU-4079 RJS	1177
26530 7590 10/02/2008 LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1600 CHICAGO, IL 60604				
EXAMINER				
GOLOBY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
10/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/523,566

**Applicant(s)**

YAGISHITA, KAZUHIRO

**Examiner**

James Goloboy

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 13-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-11, 13-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The notice of allowable subject matter in the office action mailed 7/24/08 is withdrawn and prosecution reopened. While the references do not teach an alkyl salicylate meeting the limitations of type (A) of amended claim 1, Katafuchi and Chambard do teach an alkylsalicylate meeting the limitations of type (B) of claim 1, as discussed in the office action mailed 12/27/07. As the alkylsalicylate of type (A) is an optional component, and can be replaced by the alkylsalicylate of type (B), the claims are still obvious over the references of record. The examiner regrets the error.

### ***Claim Objections***

2. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, amend the claim to place the claim in proper dependent form, or rewrite the claims in independent form. Claim 1 has been amended to require that one of  $R^1$  and  $R^2$  in formula (1) is an alkyl group which has 10 to 40 carbon atoms, and the other is a hydrocarbon group which has less than 5 carbon atoms and may contain oxygen or nitrogen. Claim 3, which depends on claim 1, recites the requirement that either one of  $R^1$  and  $R^2$  is an alkyl group with 10 to 40 carbon atoms, but limits the other to less than 10 carbon atoms, which is broader than the limitation of the parent claim.

***Claim Rejections - 35 USC § 103***

3. Claims 1-2, 5-6, 8-9, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katafuchi.

The rejections of claims 1-2, 5-6, 8-9, 11, and 14-15 are adequately set forth in paragraph 2 of the office action mailed 12/27/07, and paragraph 2 of the office action mailed 7/24/08, which are incorporated here by reference. In particular, Katafuchi discloses in column 3 lines 18-27 alkylsalicylates meeting the limitations of the monoalkylsalicylates of type (B) of claim 1. Katafuchi therefore renders claims 1-2, 5-6, 8-9, 11, and 14-15 obvious for the case where only type (B) is present in the composition, and additionally renders claim 13 obvious for that case.

4. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katafuchi in view of Curtis.

This rejection is adequately set forth in paragraph 3 of the office action mailed 12/27/07, which is incorporated here by reference.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katafuchi in view of Papay.

This rejection is adequately set forth in paragraph 4 of the office action mailed 12/27/07, which is incorporated here by reference.

6. Claims 1-4, 8-9, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chambard.

The rejections of claims 1-4, 8-9, 11, and 14-15 are adequately set forth in paragraph 6 of the office action mailed 12/27/07. When the alkylsalicylate of Chambard has only one alkyl group, it meets the limitations of the claims for the case where the alkylsalicylate of type (B) is present. Claim 13 is met for this case as well.

### ***Response to Arguments***

7. Claim 1 has been amended to limit the alkylsalicylates of type (A) to those where one of R<sup>1</sup> and R<sup>2</sup> in formula (1) is an alkyl group which has 10 to 40 carbon atoms, and the other is a hydrocarbon group which has less than 5 carbon atoms and may contain oxygen or nitrogen. While the references do not teach an alkyl salicylate meeting the limitations of type (A) of amended claim 1, Katafuchi and Chambard do teach an alkylsalicylate meeting the limitations of type (B) of claim 1, as discussed in the office action mailed 12/27/07. As the alkylsalicylate of type (A) is an optional component, and can be replaced by the alkylsalicylate of type (B), the claims are still obvious over the references of record.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797